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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,063	10/13/2000	Michael J. Natan	SURR-30	1277
7590	11/16/2004		EXAMINER CROSS, LATOYA I	
Barry J Swanson Swanson & Bratschun LLC 1745 Shea Center Drive Suite 330 Highlands Ranch, CO 80129			ART UNIT 1743	PAPER NUMBER

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/688,063	NATAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	LaToya I. Cross	1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

## ***Office Action Summary***

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 28 September 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 10,11,13,16-19,33,36,52,59-63 and 66 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 66 is/are allowed.

6)  Claim(s) 10,11,13,16-19,33,36,52 and 59-63 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 14.1)

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9-28-04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's IDS submission filed on September 28, 2004 has been entered. Claims 10, 11, 13, 16-19, 33, 36, 52, 59-63 and 66 are pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10, 11, 13, 16-19, 33, 36, 52 and 59-63 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent publication 2003/0036096 to Ravkin et al.

Ravkin et al teach a chemical library compositions and methods for detection and quantification of target analytes. Each chemical library composition is carried on a carrier support, wherein the composition is coded at different locations on the support. The method comprises contacting the sample having target molecules with a chemical library composition.

The chemical library composition is disposed on a carrier as a detectable code combination. Each carrier has a code combination defined detectable indicia at a particular position on the carrier (¶ 29). Since each carrier has a number of code positions that are "specified" positions, the positions are "position addressable". The reference teaches that as many as  $M^N$  ( $M > 2$  and  $N > 2$ ) number of different code combinations may be possible. The detectable indicia are equivalent to Applicants' extraction probes. With respect to claim 10, Ravkin et al teach that the carriers may be organized in a capillary tube (¶ 108). After the sample is contacted with the carrier having the detectable code combinations, the carriers are "scanned" for decoding and identifying the specific compound carried on the carrier. The reference teaches that the carriers have at least  $N > 1$  specified code positions and  $M > 1$  detectable indicia at each code position and a different chemical compound carried on each different coded carrier (¶ 38). Thus, each indicium may be differentiated by its code position or its chemical composition. With respect to claims 17-19, Ravkin et al teach examining and scanning the carriers for the presence of bound analytes by light microscopy, wherein the target is detectable in its native form or by a fluorescent label (¶ 47-48). Ravkin et al teach that the detectable indicia may be oligonucleotides, peptides, nucleic acids or receptors (¶ 38). With respect to claims 33 and 52, Ravkin et al teach that the carrier may be in the form of layers, wherein each layer has individually identifiable indicia (¶¶ 66, 86). Regarding claims 59-63, Ravkin et al teach that the carrier may be made of fibers in the range of 3 um to 100 um (¶ 56).

Therefore, for the reasons set forth above, Applicants' invention is deemed to be anticipated by Ravkin et al.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 16-19, 33 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 14-16 of U.S. Patent No. 09/920,440. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant method claims use "combinatorially-derived" encoded extraction phases, whereas the claims of the '440 application recite "different" encoded extraction phases. The claims are not patentably distinct because the instant claims (reciting "combinatorially-derived" encoded extraction phases) are merely broader than the claims of the '063 application (reciting "different" encoded extraction phases). Thus, the instant claims are anticipated by the claims of the '440 application. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

### ***Allowable Subject Matter***

5. Claim 66 is allowed. The prior art of record fails to teach or fairly suggest a method for extracting analytes using an extraction probe comprising a freestanding particle having a varying composition along its length.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden  
Supervisory Patent Examiner  
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